

## **RESPONSE**

### **Remarks**

Claims 1-11, 13-16, 22-25 and 41-44 are pending in the Application. Claim 1 and 41 are in independent format. Applicant now responds to the Examiner's assertions.

The Applicant asks the Examiner carefully consider the comments below. If the Examiner carefully and realistically considers the comments below he will see his rejections cannot be maintained.

### **IMPROPER FINAL REJECTION**

The Examiner has raised a new rejection Stein in view of *He*. The *He* patent was not asserted nor mentioned in the rejections of the previous office action. This is the first time the Applicant has seen a rejection over *He*. Therefore, the Applicant submits that the Final Rejection sent by the Examiner for Stein in view of *He* is improper under MPEP §706.07(c) and the Applicant requests the Final Rejection be withdrawn. The Applicant responds to the Examiner's assertions in an Amendment and Response to the office action as follows.

### **Section 103 Rejection**

Claims 1-11, 13-14, 16, 22-32, 34-35, 37-46, 48-59, 61-62, 64-71, 78-88, 93-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein in view of U.S. Patent No. 5,642,407 to *He*.

### **First Section 103 Response**

The Applicant traverses all of the Examiner's assertions, accepts all of the Examiner's admissions and responds as follows. The Applicant may comment on only selected specific comments by the Examiner, but the Applicant still intends to traverse all of the Examiner's assertions.

#### **Claims 1 and 41:**

The Examiner is reminded that to establish a case of *prima facie* obviousness of a claimed invention in the first place, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). Stein does not teach or suggest all of the claim limitations taught by Claim 1.

The Examiner **admits** that Stein does not teach or suggest the claim limitation of handling of non-existent numbers as taught by the applicant. Thus, the applicant's invention cannot be obvious in view of Stein alone and the Examiner's rejection must be based upon the combination of two or more references.

The Examiner then asserts that "*He* teaches a system that intercepts numbers as described by the Applicant as non-existent and then transfers an advertisement to the caller (See Col. 2, lines 34-48 of *He*). It would have been obvious to one of ordinary skill in the art to have incorporated such non-existent number aspects as taught by *He* into the Stein system in order to cast a wider net to generate more revenue."

The Examiner is reminded that to establish a *prima facie* case of obviousness in the first place with a combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art reference must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The Examiner is also reminded that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

The Examiner is also reminded that if the proposed modification or combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti* 270 F.2d 810 (CPPA 1959).

First, as discussed with the Examiner in the previous phone interview, Stein teaches in paragraphs [0021] and [0023] that Stein requires a set of numbers that the redirection system must subscribe to from a telecom provider before any redirection can take place. The operator of the telephone call redirection system 20 must have subscription rights to such numbers all redirection numbers. The subscription numbers of Stein do not and cannot include all unavailable numbers as taught by the Applicant.

*He* has no such subscription requirement (Neither does the Applicant's invention). Thus, the proposed combination of Stein and *He* would render the Stein invention unsatisfactory for one of its intended purposes, namely, redirecting vanity numbers such as "1-800-something" numbers close in the dialing sequence to the vanity numbers but subscribed by the Stein system. Therefore, there is no motivation or suggestion to combine Stein and *He*. Thus, the Applicant's claimed invention cannot be obvious over the combination of Stein and *He* based on the holding of *In re Gordon*.

Second, there is no reasonable expectation of success of combination Stein and *He*. As was discussed above, Stein requires its system subscribe to numbers close to vanity numbers such as "1-800-something." *He* has no subscription requirement. In addition, *He* will redirect only certain calls to audio advertising messages based on a predicate action list stored in a table, populated with specific attributes and rules implemented by a telephone company (Col. 3, lines 8-10). The specific attributes include caller information such as caller name, interexchange carrier, last phone bill amount, etc. (Col. 3, lines 37-38). Stein has no such predicate action table requirement (Neither does the applicant's claimed invention). In addition, *He* teaches that if none of the conditions in the predicate action table are satisfied then a default action such as a *busy* signal is provided to the caller (instead of any advertising at all). (Col. 8, line 3-8). Thus, there is no reasonable expectation of success of combining Stein and *He*.

Combining Stein and *He* also changes the principal operation of *He* by requiring a subscription service to a large number of available numbers close to vanity numbers such as "1-800-something" also changes the principal operation of Stein by requiring a

predicate action table with default actions that could lead directly to a busy signal instead of presenting advertising to a caller if a set of pre-defined conditions in the predicate action table are not met. Therefore, combining Stein and *He* violates the holding of *In re Ratti* and the combination of the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Combining Stein and He also does not teach all of the claim limitations recited by Claim 1. In addition Claim 1 does not have the required limitations of the subscription service of Stein not the predicate action table of *He*.

Since there was no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, there was no reasonable expectation of success of combining the invention taught by the references and the combination of the prior art references still does not teach or suggest all of the claim limitations of the Applicant's invention, the Examiner failed to establish a *prima facie* case of obviousness based on the holding of *In re Vaeck*. Therefore, the Applicant requests the §103 rejection be immediately withdrawn.

The Examiner is also reminded to that even if a *prima facie* case of obviousness is established by an Examiner, which is not the case here, the *prima facie* case of obviousness may be rebutted by showing the prior art, in any material aspect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

As was discussed above, Stein teaches in paragraphs [0021] and [0023] that Stein requires a set of numbers that the redirection system must subscribe to from a

telecom provider before any redirection can take place. *He* teaches the requirement of a predicate action table to direct calls. If none of the conditions in the predicate action table are satisfied then a default action such as a *busy* signal is provided to the caller (instead of any advertising at all). (Col. 8, line 3-8). Thus, both Stein and *He* teach away from the claimed invention in the one or more material aspects. Thus, even if the Examiner had established a *prima facie* case of obviousness by combining Stein and *He*, it has been rebutted under the holding of *In re Geisler*.

The remaining are dependent claims adding additional features to the invention. The Examiner is also reminded that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is not obvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Thus, the remaining dependent claims are not obvious under the holding of *In Re Fine*. Therefore, the Applicant requests the Examiner immediately withdraw the rejections of the dependent claims.

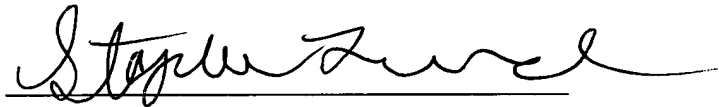
**CONCLUSION**

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §103 rejections of all the claims and pass all of the pending Claims 1-11, 13-16, 22-25 and 41-44 immediately to allowance.

Respectfully submitted.

**Lesavich High-Tech Law Group, PC (32097)**

Dated: August 8, 2006

A handwritten signature in cursive script, appearing to read "Stephen Lesavich", written over a horizontal line.

**Stephen Lesavich, PhD**

Reg. No. 43,749